

5010
518 Rec'd PCT/PTO

JUL 2001

1103326-0590

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Asghar, et al
Serial No. : 09/381,055 (U.S. National Stage
of International Application No. PCT/SE99/00702)
Examiner : To Be Assigned
Filed : September 13, 1999 Group Art Unit: To Be Assigned
For : NOVEL USE

I hereby certify that this paper is being
deposited with the United States Postal
Service as first class mail in an envelope
addressed to: The Assistant Commissioner
for Patents, Washington, D.C. 20231, on
July 27, 2001.

Richard J. Sterner

Agent Name

Richard J. Sterner
Signature

35,372

PTO Reg. No.

July 27, 2001

Date of Signature

BOX PCT
The Assistant Commissioner for Patents
Washington, D.C. 20231

ATTN: PCT LEGAL OFFICE

RECEIVED
05 SEP 2001
Legal Staff
International Division

**SECOND RENEWED PETITION UNDER
37 CFR §1.181(a) TO WITHDRAW HOLDING OF ABANDONMENT**

Sir:

This is in response to the PCT Legal Office's May 30, 2001
Decision on Applicants' April 6, 2001 Renewed Petition under 37
C.F.R. §1.181(a) to Withdraw Holding of Abandonment.

I. Summary of Applicant's Argument

For the reasons set forth below, Applicants respectfully submit that the Decision is in error in view of 37 C.F.R. §§1.10 and 1.25(a). Replenishment of Applicants' Deposit Account was made by Applicants under 37 C.F.R. §1.10 on September 16, 1999. Therefore, in accordance with 37 C.F.R. §1.10, remittance to restore Applicants' Deposit Account to its established normal deposit was received by the Office on September 16, 1999 in satisfaction of 37 C.F.R. §1.25(a). Accordingly, in view of the express language and intent of delivering mail to the Office pursuant to 37 C.F.R. §1.10, the date of posting funds to Applicants' Deposit Account must be September 16, 1999. There is no statutory support to uphold a contrary conclusion.

II. Argument

The PCT Attorney rendering the Decision on Applicants' Petition has again held that Applicants' case for inappropriate holding of abandonment is unpersuasive. The Attorney states that sufficient money must be in the account at all times and, essentially, that the fact that Applicants submitted sufficient funds prior to the PTO's attempt to deduct the filing fees is irrelevant.

The Attorney has referred to portions of 37 CFR §1.25(a), but has not commented on a key passage from that section, which was quoted by Applicants in their April 6, 2001 Petition. Applicants believe it is important to bring that passage to the Attorney's attention again:

At the end of each month, a deposit account statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit.

In response to Applicants' arguments set forth in their April 6, 2001 Petition, the Attorney comments: "The monthly Deposit Account statement is not a condition precedent to any obligation by applicants to meet their financial obligations." Such an assessment would seem to be in direct conflict with what is clearly meant by the above-quoted passage from 37 CFR §1.25(a), namely, that it is the reliable rendering of the deposit account statements by the PTO that is the trigger for replenishment of deposit accounts by applicants.

The above-quoted passage states the requirement of timely remittance of funds by applicants upon receipt of a deposit account statement from the PTO. Nothing is expressly stated in this section about any requirements in connection with, for example, the posting of funds, depositing of funds and what is meant by "prompt" remittance. Certainly, remittance by Express Mail the day after receipt of the Deposit Account statement must

not only be considered prompt but in fulfillment of the intent of §1.25(a).

Commenting on some of the documentation provided by Applicants in their previous Petition and purporting to explain why "the date of posting will not be changed," the Attorney comments: "The postcard receipt was not date stamped, nor should it have been. Deposit accounts are for the convenience of attorneys...." In the first place, Applicants do not understand what relevant connection is being made between these two statements.

In any event, Applicants remind the Attorney that funds sufficient to cover the filing fee were submitted under 37 CFR §1.10 on September 16, 1999. In 37 CFR §1.10, it is stated: "Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the 'Express Mail Post Office to Addressee' service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS." In this case, the date of deposit, under 37 CFR §1.10, was September 16, 1999, i.e., before the date (September 17, 1999) that an attempt was made to charge the filing fee to Applicants' Deposit Account.

Thus, whether or not Applicants' return receipt postcard was date stamped and whether or not the PTO's omission was appropriate, it must not only be considered that Applicants complied with the requirement of "prompt" remittance set forth in 37 CFR 1.25 (a) but it must also be considered that sufficient

funds were present in the Deposit Account prior to the attempt to deduct the application filing fee. Furthermore, the Attorney's assessment of what constitutes an elapsed amount of time between submission and posting of the replenishment funds that is "well within normal business practices" cannot be applied to the present situation in view of the relevant sections of 37 C.F.R. §§1.10 and 1.25(a). The date of posting of funds must be considered to be September 16, 1999.

For the above reasons, the Attorney's reference to "delay by Applicants in depositing funds in their Deposit Account prior to receiving a monthly statement" and his branding of that "delay" as "misguided" are inappropriate. Again, referring to the above-quoted passages from 37 CFR §§1.10(a) and 1.25(a), there was no "delay" by Applicants; the Deposit Account was replenished, under 37 CFR §1.10, by Applicants immediately upon receipt of the monthly Deposit Account Statement and prior to the attempt to charge the filing fee. Furthermore, as Applicants previously asserted, the Attorney, or any other PTO representative, could check and see that Applicants have an unblemished record of immediately responding to receipt of deposit account statements by replenishing their account. Still further, if Applicants were in fact "misguided," it was only through their naïve belief that they could rely on a timely rendering of the monthly Deposit Account statement by the PTO, thus allowing them to fulfill their part of the arrangement between them and the PTO regarding deposit accounts set forth in §1.25(a).

In view of the facts and circumstances set forth above, Applicants have, despite their diligence, been improperly penalized, and the holding of abandonment should be withdrawn. It is respectfully requested that such be effected, that the required filing fee be charged to Deposit Account No. 23-1703 and that the application be properly processed and brought forward for examination on the merits in the U.S. It is further requested that the application be granted the 102(e) date of September 13, 1999 to which it is entitled.

The Assistant Commissioner is hereby authorized to charge any additional fee which may be required for any reason to Deposit Account No. 23-1703.

Dated: July 27, 2001

Respectfully submitted,



Richard J. Sterner
Reg. No. 35,372

Applicants' Agent
Customer No. 007470
(212) 819-8200

Agent's Direct line:
(212) 819-8783